

## REMARKS

Claims 1-8, 12-21, and 23-24 are pending in the application. Claims 9-11 and 22 are cancelled. Claims 1-3, 5-6, 12-21, and 23 are amended and Claim 24 is added to the application. Favorable reconsideration is respectfully requested in light of the following Remarks.

### I. The Claims Define Patentable Subject Matter

1. The Office Action rejects Claims 1-4 and 16 under 35 U.S.C. § 102(e) as being anticipated by Ellison (U.S. Patent No. 6,399,193, hereinafter "Ellison"). The rejection is respectfully traversed.

Claim 1 is amended to recite "a decorative web layer" instead of "a decorative layer" to further distinguish the invention from the cited prior art. Support for the term "web" can be found in the specification on p. 2 (first paragraph of the Detailed Description) in that the decorative material is uncoiled from a coiled roll to form a sheet of decorative material including materials such as cloth, denim, and other fabrics. Also, the web material is illustrated in Figs. 1 and 2 of the application as originally filed, showing a web material 11 and 20, respectively, being uncoiled from a coiled roll. Thus, independent Claim 1 specifies, *inter alia*, providing a decorative web layer.

Ellison discloses a paint film having a clear coat layer, a colored layer including an adhesive and at least one color pigment, and a support layer of an extruded film adhered to the color layer. The color layer as disclosed by Ellison is applied by known coating methods such as slot die, reverse roll, knife over roll, rotary screen or other means to yield a smooth uniform coating, free from streaks or other objectionable defects which may detract from DOI or overall appearance. With each coating method, solvent addition may be necessary to adjust viscosity for best coating by that method. *See col. 5, lines 44-52*. Ellison further discloses that alternatively, the color layer may be coated onto the support layer, dried and nipped to the clear coat layer. *See col. 5, lines 58-59*. Furthermore, Ellison discloses that the color layer can be coated in layers in one step, for

example by laminar or cascade coating, or sequential application of layers. *See col. 5, line 66 – col. 6, line 1.* This is clearly different from the present invention as defined in amended Claim 1 reciting the step of providing a decorative web layer.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See* MPEP §2131. Contrary to the Office Action that all of the elements of Claim 1 are disclosed in Ellison, at least the step of providing a decorative web layer is not disclosed, taught, or suggested in Ellison, so the rejection is unsupported by the art and should be withdrawn. As stated in paragraph 6 of the Office Action, “Ellison does not teach providing a decorative layer of woven fabric or screening.”

Also, paragraphs 6, 7 and 8 in the Office Action state that it would have been obvious to use woven fabric or screening as the decorative layer of Ellison “in order to enhance the aesthetic appeal of the exterior panel.” However, this reasoning employs improper hindsight. That is, enhancing the aesthetic appeal of the exterior panel is the precise rationale set forth in the subject application for performing the claimed method. (See page 2, “to provide an aesthetically pleasing appearance,” or page 3, “thus creating an aesthetically pleasing pattern.”) The Patent Office is not permitted to rely on the applicant’s own disclosure as done in the outstanding Office Action.

For at least this reason, Claim 1 is allowable over the applied art. Claims 2-4 and 16, which ultimately depend from Claim 1, are likewise allowable over the applied art. Withdrawal of the rejection is respectfully requested.

2. The Office Action rejects Claims 18, 21, and 23 under 35 U.S.C. § 102(e) as being anticipated by Ellison (U.S. Patent No. 6,399,193, hereinafter “Ellison”). The rejection is respectfully traversed.

Claim 18 is amended to recite “a decorative web layer” instead of “a decorative layer” to further distinguish the invention from the cited prior art. Thus, independent Claim 18 specifies, *inter alia*, the step of providing a decorative web layer.

As was discussed above with respect to Claims 1-4 and 16, a decorative web layer is not disclosed by Ellison.

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Thus, contrary to the Office Action that all of the elements of Claim 18 are disclosed in Ellison, at least the step of providing a decorative web layer is not disclosed, taught, or suggested in Ellison, so the rejection is unsupported by the art and should be withdrawn.

For at least this reason, Claim 18 is allowable over the applied art. Claims 21 and 23, which depend from Claim 18, are likewise allowable over the applied art. Withdrawal of the rejection is respectfully requested.

3. The Office Action rejects Claims 5-8 under 35 U.S.C. § 103(a) as being unpatentable over Ellison (U.S. Patent No. 6,399,193, hereinafter "Ellison") in view of Mueller (U.S. Patent No. 5,230,906, hereinafter "Mueller"). The rejection is respectfully traversed.

Claim 5 is amended to recite "a decorative web material" instead of "a decorative material" to further distinguish the invention from the cited prior art. Thus, independent Claim 5 specifies, *inter alia*, the step of providing a layer of decorative web material.

As was discussed heretofore, Ellison discloses a paint film including a clear coat layer of a sheet of polymer, a color layer including a pressure-sensitive adhesive and at least one color pigment, and a support layer of an extruded film adhered to the color layer. The paint film is produced in-line and then taken to vacuum forming or thermoforming. As was discussed heretofore, Ellison discloses that the color layer which contains pigments as the decorative material is applied by known coating methods. In contrast, the present invention as defined in amended claim 5, provides a decorative web material as a decorative layer. As a result, the present invention can provide more variety in terms of decorative appearance by providing a decorative web material. For example, as disclosed in the specification as originally filed, the decorative web material may include any of several types of materials, such as cloth, denim, Lycra, or other fabrics, it may be colored, textured, reflective, or any combination thereof. Furthermore, as disclosed in the specification as originally filed, fiberglass material may be used, and reinforcement material such as metal or plastic screening may also be used. Thus, in accordance with the present invention, exterior body panels for use on automotive

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vehicles can be produced that fulfill a commercial demand for a product that cannot be met by Ellison.

Mueller discloses a method of forming a prepreg in-line. The prepreg is prepared by continuously impregnating a fibrous web with a liquid, curable resin composition. The liquid resin composition is contained within a trough and the fibrous web is passed through this trough and leaves the resin bath in a fully impregnated state. This process creates a prepreg that has a top and bottom layer equal in composition and thickness. The present invention, however, can provide a top and bottom layer different in thickness and composition. The Office Action equates the fibrous web of Mueller to a decorative material. However, Mueller does not disclose a decorative material. The method disclosed by Mueller provides a sophisticated method of manufacturing a prepreg, and the inventive idea is to impregnate a fibrous, web-like material with a relatively low viscous curable resin. *See col. 3, line 65 – col. 4, line 1.* The prepreg produced by the method disclosed in Mueller is then used in further processes to make construction parts, car parts and boat bodies.

The method of the present invention provides an in-line process for making exterior body panels from a decorative web layer to a finished product. The decorative web layer in accordance with the present invention provides for more variety of decorative appearance, such as patterns, reflective appearance, textured appearance or combinations thereof. Thus, the present invention fulfills a commercial need for exterior body panels that cannot be met by Ellison or Mueller alone or combined. Reference is also made to the arguments set forth above with respect to claim 1, as they are applicable to claim 5 as well.

In view of the foregoing, it is respectfully submitted that the combination of Ellison and Mueller does not teach all the claim limitations, as recited in claim 5. Further even if the combination of Ellison and Mueller taught all the claim limitations, there is no motivation to combine the teachings of Ellison and Mueller to meet the claimed invention.

For at least this reason, Claim 5 is allowable over the applied art. Withdrawal of the rejection is respectfully requested. Furthermore, Claims 6-8, which depend from

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Claim 5 are likewise allowable over the applied art. Withdrawal of the rejection is respectfully requested.

4. The Office Action rejects Claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Ellison (U.S. Patent No. 6,399,193, hereinafter "Ellison"). The rejection is respectfully traversed.

Claims 12 and 14 ultimately depend from claim 1 and are likewise submitted to be allowable for at least the reason above. Withdrawal of the rejection is respectfully requested.

5. The Office Action rejects Claims 13, 15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Ellison (U.S. Patent No. 6,399,193, hereinafter "Ellison") in view of Mueller (U.S. Patent No. 5,230,906, hereinafter "Mueller"). The rejection is respectfully traversed.

Claims 13, 15, and 17 depend from claim 5 and are likewise submitted to be allowable for at least the reason above. Withdrawal of the rejection is respectfully requested.

6. The Office Action rejects Claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Ellison (U.S. Patent No. 6,399,193, hereinafter "Ellison"). The rejection is respectfully traversed.

Claims 19 and 20 depend from Claim 18 and are likewise submitted to be allowable for at least the reason above. Withdrawal of the rejection is respectfully requested.

7. The Office Action rejects Claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Ellison (U.S. Patent No. 6,399,193, hereinafter "Ellison") as applied to claim 18 above and further in view of Mueller (U.S. Patent No. 5,230,906, hereinafter "Mueller").

Claim 22 is canceled and the limitation of claim 22 is incorporated into claim 18.

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Claim 24 is newly submitted with this response as a dependent claim to Claim 1. The limitation of claim 24 is supported by the specification as originally filed stating on page 3, lines 6-7, that each side of the decorative material is sprayed with a mixture of liquid or powdered epoxy and plastic.

The dependent claims of the application are amended to be in agreement with the amendment of the independent claims.

Claim 3 is amended to correct a clerical error.

Claims 5, 15, and 17 are amended to replace the term "resin" with the term "plastic" as disclosed in the specification as originally filed, wherein it is stated that a mixture of epoxy and plastic is provided to the decorative web layer rather than a mixture of epoxy and resin.

Claims 12, 13, and 19 are amended to replace the term "woven fabric" with the term "fabric". The specification as originally filed does not limit the fabric to a woven fabric.

Furthermore, the first paragraph of the Detailed Description of the Preferred Embodiments section starting on page 2, line 28 and ending on page 3, line 5 was amended to read "decorative web material" instead of "decorative material". The term "decorative web material" is supported by the specification and figures as set forth above with respect to claim 1.

## II. Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for Allowance. Favorable consideration and prompt Allowance of the Application is earnestly solicited.

Should Examiner Lee believe anything further would be desirable in order to place the Application in better condition for Allowance, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

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As this response has been timely filed within the set period of responses,  
no petition for extension of time or associated fee is required.

Respectfully submitted,

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